

RECEIVED  
CENTRAL FAX CENTER

PATENT

SEP 22 2005

IBM/02B  
Confirmation No. 9272

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Joseph Phillip Bigus et al.  
 Serial No.: 09/431,833  
 Filed: November 2, 1999  
 For: INTELLIGENT AGENT WITH NEGOTIATION CAPABILITY AND METHOD  
 OF NEGOTIATION THEREWITH

PRE-APPEAL BRIEF REVIEW REQUEST

Mail Stop AF  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

This paper is submitted in reply to the final Office Action dated June 22, 2005, and is submitted in connection with a Notice of Appeal. Applicants respectfully request pre-appeal brief review of the final rejections in the above-identified patent application for the reasons set forth below.

In particular, Applicants respectfully request review of the final rejections based upon the fact that the Examiner is engaging in piecemeal examination, the final Office Action does not provide sufficient support for each and every rejected claim pending in the application, and the rejections in the final Office Action are based upon art that effectively discloses the same basic concepts as other art that Applicants have already successfully overcome in the course of prosecution.

First, with respect to piecemeal examination, by Applicants' count, the current Office Action represents the seventh separate rejection of the claims (the first six having been applied against the claims as originally filed). Furthermore, this rejection comes after two separate attempts by Applicants to obtain appellate review of the application, which in both instances resulted in prosecution being reopened and a new office action being issued.

Based upon this prosecution history, as well as the substance of the rejections, Applicants are deeply concerned that the filing of another appeal brief, and the associated time and expense

Page 1 of 5  
 Serial No. 09/431,833  
 Pre-Appeal Brief Review Request dated September 22, 2005  
 Reply to Final Office Action mailed June 22, 2005  
 IBM Docket R0996054L  
 WH&E IBM/02B  
 K:\lm\02b\pre-appeal brief review request.wpd

incurred in connection therewith, would simply result in prosecution once again being reopened and a new office action being issued applying new references that are no better than the art that has already been successfully overcome. It is a grave disservice to Applicants to perpetually issue new rejections that do not ever progress the case toward some resolution.

Moreover, given that this application has now been before an appeal conference on two other instances, and has resulted in each instance in a finding that the Examiner's rejections were not sufficiently supported to sustain appellate review, Applicants submit that the Examiner has been given more than ample opportunity to locate relevant prior art to apply against the claims, and has failed to do so. After seven separate office actions, further searching by the Examiner should not be necessary at this stage of prosecution. As a result, Applicants request that all rejections be withdrawn and the application be passed to allowance.

Second, with respect to the lack of support for the Examiner's rejections, Applicants note that, with the exception of the Office Action of November 13, 2003 (paper 11), the Examiner has never substantively addressed Applicants' arguments in support of patentability. Instead, each Office Action takes the same basic form: the text of each claim is cut & pasted into the Office Action, a list of passages from the prior art is cited without any explanation of how the passages relate to the claim language in question, and a brief statement of motivation to combine is made. Of note, the rejection of each dependent often cites the exact same passages in the references, and states nothing further than "as per claim X, reference Y teaches <insert text of claim X>" There